

### REMARKS

Reconsideration of this application in light of the present remarks is respectfully requested.

Claims 1-25 have been rejected.

Claims 1-25 are pending in this application.

Claims 1, (2?), 9-11, 18 and 25 have been rejected under 35 U.S.C. §103(a) as being anticipated by Jagadeesan (US 7,003,298) in view of Noguera-Rodriguez et al. (US 6,687,249, hereinafter "Rodriguez"). This rejection is respectfully traversed.

Applicant's invention provides a technique for switching a plurality of connections for one mobile unit from one multi-connection communication system to another communication system that only supports a single connection. This is accomplished by placing all but one connection in the multi-connection system on hold while maintaining contact therewith, then switching the held connections between the one active handover connection in the second system, in accordance with various parameters of the present invention. Further, the plurality of connections in the multi-connection system are maintained such that handing back from the single-connection system to multi-connection system is readily accomplished.

Regarding the first element of claim 1, the Examiner admits that Jagadeesan fails to disclose forwarding all the connections directly from the first (multi-connection) communication system to the second (single-connection) communication system. In this case the Examiner has cited Rodriguez as describing forwarding a plurality of connections from a first communication system to a second communication system.

Rodriguez describes the passing of control of network diversity legs from one controller to a second controller. Applicant submits that this is completely different than forwarding a multiple-connection call between two systems. Firstly, Rodriguez is only dealing with one system (network). Therefore, there is no forwarding between different communication systems. Secondly, only the *control* of network legs is forwarded. Thirdly, the leg connections themselves remain the same after control is forwarded. Therefore, the leg connections are not forwarded or transferred.

Therefore, applicant respectfully submits that neither Jagadeesan nor Rodriguez, in combination or alone, suggest or disclose forwarding a plurality of connections from a first communication system to a second communication system.

Regarding the second element of claim 1, the Examiner recites that Jagadeesan describes entering a connection into a holding state. In particular, the Examiner appears to explain that in order to handoff a call from one connection leg to another connection leg it is necessary to transmit the signal for the handoff on the same one connection leg as the call, and that this interrupts the call which is the same as placing the call on "hold", and that this is obvious to one skilled in the art. Applicant respectfully counters that it is obvious to one skilled in the art that handoff signals utilize a different protocol layer than the actual call and that handoff signals do not interrupt a call, and that even if there were an interruption (which is common in packet data signaling) this can not be considered a "hold" condition as is known in the art.

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. In particular, none of the cited art discloses or even suggest a call that is placed on "hold". Thus, the Jagadeesan reference clearly fails to render obvious the claims.

In addition, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the Applicant's specification, it is a substantial benefit to use the claimed invention because it permits the handoff of a multiple connection call to a system that only provides only one connection. Jagadeesan (see abstract), describes a handoff between two connections to a user in a communication system while keeping *both* connections active. This solution would not work for applicant's problem since applicant seeks to provide handoff to a user in a communication system that only has one connection. Therefore, two connections could not be maintained. As a result, Jagadeesan does not suggest the desirability of the claimed invention.

Applicants' specification specifically teaches how to use only one connection by using a "hold" state on other connections, the hold state being responsive to various parameters. In this sense, a "hold" state is simply known in the art as placing a call on hold without hanging up on it. The Examiner's explanation that it is commonly known that any type of interruption can be considered a "hold" is not acceptable. Moreover, deficiencies of the cited references (Jagadeesan) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art). In this case, no art has been presented that describes "holding" a call.

Jagadeesan discloses a technique to handover a call from one communication mode to another communication mode while keeping both connections active. Jagadeesan does not suggest or disclose the placing of all but one of the plurality of connections on hold while handing over the one active connection. Jagadeesan does not disclose placing a connection on hold at all. Jagadeesan specifically describes keeping both the connections actively transmitting data or dropping one of the connections (abstract, col. 7 line 63 to col. 8 line 15), which teaches away from applicant's holding condition. Therefore, Jagadeesan could not have envisioned switching the one handover connection between active and held connections, as recited in amended claim 1. Jagadeesan is missing at least the following elements of applicant's invention; a) a plurality of connections, b) forwarding the plurality of connections between systems, c) holding all but one of the connections, and d) switching the held connections one-at-a-time to the active handover connection. As a result, applicant respectfully submits that amended claim 1 is novel and non-obvious over Jagadeesan.

The Examiner has admitted that Jagadeesan fails to disclose entering a connection into a holding state *under direction of the second communication system*. In this case the Examiner has cited Rodriguez as describing placing a plurality of connections in a first communication system in a holding state under direction by a second communication system.

Rodriguez describes the passing of control of network diversity legs from one controller to a second controller. Applicants are willing to submit that the change in control is *directed by the second controller*. However, applicant disagrees that Rodriguez teaches entering a plurality of connections into a holding state, under the direction of a second controller or not. Nowhere does Rodriguez describe or suggest placing connections on hold.

Therefore, applicant respectfully submits that neither Jagadeesan nor Rodriguez, in combination or alone, suggest or disclose the elements; a) forwarding a plurality of connections from a first communication system to a second communication system, b) placing at least one of these connections on hold, c) the command for placing the connection on hold comes from the second communication system, and d) switching the held connections one-at-a-time to the active handover connection.

The Examiner suggests that the motivation for modifying Jagadeesan with Rodriguez is to maintain control of user equipment when the user moves about with a single network. However, applicant does not see the relevance of this motivation, inasmuch as applicant's invention applies to a mobile user who moves between networks, where one network supports a multiple-connection call and another network only support a single-connection call.

Regarding the third element of claim 1, applicant is willing to submit that Jagadeesan teaches forming a handover connection to the subscriber unit through the second cellular communication system.

Regarding the fourth element of claim 1, applicant is willing to submit that Jagadeesan teaches handing over a second connection of said plurality of connections to the second cellular communication system by associating the second connection with said handover connection.

Regarding the fifth element of claim 1, applicant disagrees with the Examiner's assertion that Jagadeesan describes "means for entering said at least first connection into an active state by switching the at least first connection with the handover connection while placing the previously active second connection on hold" using the view that this element is just the reverse of the second element. Inasmuch as applicant has put forth a comprehensive argument above of why Jagadeesan does not describe the second element, it follows that Jagadeesan could not then describe the reverse thereof in this fifth element of claim 1.

Therefore, applicant respectfully submits that claim 1 is patentable and non-obvious over the cited art and asks the Examiner to withdraw this rejection.

Regarding claim 2, Rodriguez describes combining network diversity legs into a single data stream. Applicant submits that this is completely different than multiplexing. In multiplexing all the different data from each leg is submitted serially through one connection. In contrast and as known in the art, in diversity, all of the legs from each leg is the same, but only shifted in time, phase, fading, etc. Diversity is used to recover one signal by combining those from multiple sources with the hope that any signal corruption in one leg will not prevent recovery of the whole signal. Rodriguez uses diversity to combine different data legs carrying the same information in parallel to retrieve the original signal. Multiplex combining is not the same as diversity combining, and Rodriguez could not be used to provide the solution of claim 2.

Regarding claims 9 and 10, although Jagadeesan (col. 7 lines 35-45) describes handoff signals between devices, as is well known in the art, applicant submits that this is a completely different concept from *notifying a user* of the subscriber unit with a message that one of their connections is on hold (see text on page 22 lines 27-32). Moreover, Jagadeesan does not describe a plurality of connections, and does not describe a "hold" function (as detailed above), and therefore could not have envisioned notifying a user that one of a plurality of connections is

on hold. Moreover, the placing of a call on hold can not be considered as a positive notification to users of a device that their call is on hold.

Regarding claim 11, although Jagadeesan (col. 7 lines 25-30) describes voice communication, as is well known in the art, applicant submits that this is a completely different concept from *notifying a user* of the subscriber unit with a voice message that one of their connections is on hold (see text on page 22 lines 27-32). Moreover, Jagadeesan does not describe a plurality of connections, and does not describe a "hold" function (as detailed above), and therefore could not have envisioned notifying a user that one of a plurality of connections is on hold. Further, claim 11 is dependent upon claim 9, incorporated by reference, as is therefore distinct for the same reasons.

Regarding claim 18, claim is dependent upon claim 1, hereby incorporated by reference, as is therefore distinct for the same reasons.

Regarding Independent claim 25, claim 25 includes the same recitations as those of claim 1, in apparatus form, as is therefore deemed novel as well for the same reasons.

Moreover, claims 2, 9-11 and 18 are dependent on amended claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references.

Accordingly, applicant respectfully requests that the above rejection be withdrawn.

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Claims 3-8, 12-14 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jagadeesan in view of Rodriguez in view of Tellinger (US 6,792,273). This rejection is respectfully traversed.

Regarding claim 6, deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art). In this case, no art has been presented that describes "holding" a call. Therefore, one could not conclude the characteristic parameters of claim 6 could be used to determine which connection to "hold".

Regarding claims 7 and 8, none of the cited art, in combination or alone, disclose placing one of a plurality of connections in hold, and therefore the cited art could not have envisioned the further step of placing information from a held connection in memory.

Regarding claim 14, none of the cited art, in combination or alone, disclose controlling a handover of a plurality of connection in a first system by a second system, and therefore, the cited art could not have envisioned the first system re-establishing a connection if the second system fails in a handover attempt.

Regarding claim 23, none of the cited art, in combination or alone, disclose controlling a handover of a plurality of connection in a first system by a second system, and therefore, the cited art could not have envisioned the first system taking control of the connection in the second communication system following a handover.

Moreover, claims 3-8, 12-14 and 23 are dependent on amended claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references.

Accordingly, it is respectfully submitted that this rejection has been overcome.

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Claims 16, 17, 19-22 and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jagadeesan in view of Rodriguez in view of Parmar et al. (US 6,725,039). This rejection is respectfully traversed.

Claims 16, 17, 19-22 and 24 are dependent on amended claim 1, hereby incorporated by reference, and are therefore deemed patentable and distinct from the cited art for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

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Claim 15 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Jagadeesan in view of Rodriguez in view of Bedingfield, Sr. et al. (US 5,850,606). This rejection is respectfully traversed.

Claim 15 is dependent on amended claim 1, hereby incorporated by reference, and is therefore deemed patentable and distinct from the cited art for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

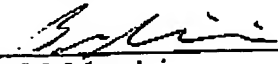
Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

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